

Remarks

Claims 48-51 and 53-56 have been canceled without prejudice to the filing of continuing applications. Accordingly, the rejection of claims 55 and 56 is moot with the cancellation of these claims. Claim 47 has been amended such that it now is, in fact, claim 47, and not claim 46 as originally presented.

Claims 1-43 and 45-56 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Accordingly, the claims have been amended to address the Examiner's issues. Specifically, the phrase "the basic substituent" has been amended to "provided that the one to three basic moieties on R" to erase any ambiguity regarding antecedent basis. Also, the structures and the text of the claims have been amended such that R_b can now be oxo by providing a double-bond. No new matter is added with this amendment, as the specification has always supported the definition of R_b to include oxo. This amendment is merely a clarification as to the correct chemistry, i.e. a double bond is necessary for the R_b to be oxo. For these reasons, withdrawal of the indefinite rejections is respectfully requested.

Next, Claims 1-43 and 45-56 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the phrases "a basic moiety" and "a basic substituent" has no metes and bounds and that there "are endless possibilities for what could fit within these phrases." Applicants have amended the claims to include a Markush of possible basic substituents, as provided for in the specification (see, for example, page 9, line 17 to page 10, line 8). No new matter is thus added with this amendment. Therefore, withdrawal of the lack of written description requirement is respectfully solicited.

Moving on, claims 1-43 and 45-56 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner contends that "it is not seen where the instant specification enables the ordinary artisan to make or use the instant compounds wherein ring containing q and t is other than a 5- or 6-membered ring." The Examiner states that there are many examples of 5- or 6-membered compounds, but that no guidance exists to make 4-, 7-, 8- or 9-membered rings. Applicants respectfully disagree. The specification at page 79, Scheme 1 shows a general synthetic strategy that can be employed to produce compounds containing a cyclic amine with *any* number of atoms C₄-C₉. This is so

because the 2-substituted cyclic amine is the starting material for the first step of the synthesis. The 2-acetic acid cyclic amines can be bought commercially, or some form of a 2-substituted cyclic amine can be bought commercially and transformed into the desired 2-acetic acid cyclic amine via procedures known in the art. For example, Scheme 2 depicts the synthesis of compound starting with a 2-(piperidin-2-yl)acetic acid 4. Those skilled in the art would realize that starting material 4 could be replaced by 2-(azetidin-2-yl)acetic acid (C₄) or 2-(azepan-2-yl)acetic acid (C₇) and the exact same chemistry could be applied. Clearly, the specification gives ample guidance as to how to synthesize all forms of cyclic amine derivatives of formula I. For this reason, withdrawal of the rejection is respectfully requested.

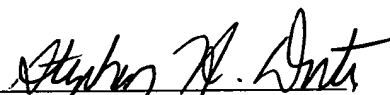
Finally, the cancellation of claims 48-51 and 53-54 renders moot their rejection under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Allowance of the claims and passage of the case to issue is respectfully solicited. Should the Examiner believe a discussion of this matter would be helpful, she is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,
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